

4 DEC 2000



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

#4

Eric B. Meyertons
CONLEY, ROSE & TAYON, P.C.
P.O. Box 398
Austin, TX 78767-0398

In re Application of
WHITLEY, Tony
Application No.: 09/486,315
PCT No.: PCT/GB97/02226
Int. Filing Date: 20 August 1997
Priority Date Claimed: None
Attorney Docket No.: 5496-00400
For: COMMUNICATION APPARATUS AND
METHOD FOR LOCATING STORED
ENTRIES IN AN ELECTRONIC
TELEPHONE DIRECTORY

DECISION ON

PETITION

UNDER 37 CFR 1.47(b)

This decision is in response to applicant's "Petition Requesting Acceptance of Application Under 37 CFR §1.47(b)," ("Pet.") filed 20 October 2000.

BACKGROUND

On 18 February 2000, applicant filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, a check in the amount of \$840.00 for the basic national fee and authorization to charge Counsel's Deposit Account No. 03-2769 for any other required fees.

On 17 April 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath/declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee pursuant to 37 CFR 1.492(e) must be provided.

On 25 May 2000, applicant filed a "Response to Notification of Missing Requirements which was accompanied by, *inter alia*, the instant petition; a declaration signed by Jai Chang Yang as Managing Director of Maxon Systems Inc., Ltd. ("Maxon"); a document titled "Declaration Pursuant to 37 C.F.R. § 1.47(b)" signed by Mr. Yang; a document titled "Declaration in Support of a Showing of Proprietary Interest" ("Harris Decl.") signed by Ian Harris, a patent attorney in the United Kingdom; a copy of Section 39, of the United Kingdom's Patent Act 1977; and a check in the amount of \$2,150.00 to cover the petition fee, surcharge fee and five-month extension of time fee.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Regarding item (1), the appropriate petition fee has been paid.

Concerning item (3), the last known address of the sole inventor, Tony Whitley is listed as 26 Beaufort Gardens, Ascot, Berkshire SL5 8PG, Great Britain.

Regarding item (4), applicant included a Declaration signed by Jai Chang Yang as Managing Director of Maxon for the sole inventor, Tony Whitley. Managing Director is a position recognized as having the authority to sign for a corporation. The declaration included the inventor's name, address, last known address, residence and citizenship. This declaration satisfies 37 CFR 1.497(a) and (b). Thus, item (4) has not been satisfied.

With regard to item (6), section 409.03(g) of the Manual of Patent Examining Procedure (MPEP), *Proof of Irreparable Damage*, states that "irreparable damage may be established by showing that a filing date is necessary to avoid an imminent statutory bar." In this case, irreparable damage appears to be alleged via applicant's statement in the petition that "[t]he filing date of the above-referenced application must be preserved to prevent irreparable damage to applicant." Pet. ¶ 7 (# 6).

A review of the above-captioned application corroborates applicant's claim that irreparable damage could occur. Specifically, the DO/EO/US mailed a Form PCT/DO/EO/905 to applicant on 27 April 2000 indicating that an executed declaration in compliance with 37 CFR 1.497(a) and (b) was required. Applicant was given one month to respond with extensions up to five-months pursuant to 37 CFR 1.136. Failure to properly respond would result in the abandonment of the application. Accordingly, it appears that applicant's statement is sufficient to meet the requirements of item (6). Thus, items (1), (3), (4) and (6) are satisfied.

However, with regard to item (2), applicant claims that the sole inventor, Mr. Whitley cannot be located. Applicants' burden in asserting this claim is to assert that a diligent effort was made to locate the inventor. Section 409.03(d) of the MPEP, *Proof of Unavailability or Refusal*, states, in part:

Where inability to find or reach a nonsigning inventor 'after diligent effort' is the reason for filing under 37 CFR 1.47, an affidavit or declaration of the facts should be submitted that fully describes the exact facts which are

relied on to establish that a diligent effort was made . . .

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration.

Here, applicant included a declaration by Mr. Yang who states that “[a] declaration was sent to the inventor’s last known address for completion, which has not been returned. I declare that I do not know the whereabouts of the inventor.” Yang Decl. § 6.

This is not sufficient. Applicant has not demonstrated that a diligent effort was made to contact Mr. Whitley. There is no indication that anyone attempted to contact Mr. Whitley via a telephone, or verify if the inventor moved and left a forwarding address. In addition, applicant has not included any documentary evidence to prove that a declaration was sent to Mr. Whitley’s last known address such as returned certified letters, etc. Applicant must also provide any other documentary evidence to demonstrate that a diligent effort was made to contact the sole inventor. In addition, it is not clear whether Mr. Whitley cannot be located since the mail was not returned, or is refusing to sign. If Mr. Whitley is refusing to sign, section 409.03(d) of the MPEP adds another requirement to proving a refusal and states, in part that:

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature.

For these reasons, item (2) is not satisfied.

Also, with regards to item (5), section 409.03(f) of the MPEP, *Proof of Proprietary Interest*, states, in part:

A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at

law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

In this case, applicants have provided a document titled a "Declaration in Support of a Showing of Proprietary Interest" signed by Ian Harris, a Chartered patent attorney in the United Kingdom which is considered as a legal memorandum. Mr. Harris read the inventor's declaration and concluded that while he has "not personally verified the statements made in the inventor's declaration signed by Jai Chang Yang . . . it is my opinion that the United Kingdom Patent Office or a United Kingdom court would award title of the invention to Maxon." Harris Decl. ¶ 4. Mr. Harris included a copy of section 39 of the United Kingdom Patents Act relied upon to base his legal conclusion as required.

However, the facts relied upon by Mr. Harris to make his conclusion found in the declaration, specifically that Tony Whitley "worked as an employee for Maxon Systems at the time of the invention" and that Mr. Whitley "made the invention as an employee of Maxon Systems in the course of his normal duties or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that the invention resulted from the carrying out of his duties" should be made by a person having firsthand knowledge of these facts. It is not clear whether Mr. Yang has the requisite firsthand knowledge of these particular facts in the declaration. In the other document signed by Mr. Yang titled "Declaration Pursuant to 37 C.F.R. § 1.47(b)," Mr. Yang does claim that all statements in that declaration are made of his own knowledge, but he does not claim that Mr. Whitley made the invention while working for Maxon in that document . As such, item (5) is not yet satisfied.

Accordingly, since applicants failed to meet item(s) (2) and (5), it is not appropriate to accept this application under 37 CFR 1.47(b) at this time.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the

contents of the letter marked to the attention of the PCT Legal Office.



Leonard Smith
PCT Legal Examiner
PCT Legal Office



James Thomson
PCT Attorney
PCT Legal Office

Tel.: (703) 308-6457